

REMARKS

In the Office Action, the Examiner stated an additional Restriction Requirement and withdrew claims 38, 40, and 41 from consideration; rejected claims 1 and 9 under 35 U.S.C. §103(a) as being unpatentable over Lenker et al. (USP 5,824,041) in view of Martinez et al. (USP 5,453,090); rejected claims 11-20, 37 and 39 under 35 U.S.C. §103(a) as being unpatentable over Lenker et al. in view of Martinez et al. further in view of Estrada et al. (USP 6,193,686), Lodin et al. (USP 5,460,608), and Thornton (USP 5,891,090); and rejected claims 1, 9-18, 20, 37 and 39 under 35 U.S.C. §103(a) as being unpatentable over Sepetka et al. (USP 5,814,062 in view of Martinez et al.

By this Response, Applicant complies with the Examiner's restriction requirement, and requests reconsideration and withdrawal of the claim rejections. In addition, Applicant requests withdrawal of the Final status of the present Office Action.

Election / Restrictions

Applicant hereby affirms the provisional election with traverse (previously made by telephone) to prosecute the invention of Group I, claims 1, 9-20, 37 and 39.

Claim Rejections Under 35 U.S.C. 103(a)

a. Claims 1 and 9

The Examiner rejected claims 1 and 9 under 35 U.S.C. §103(a) as being unpatentable over Lenker et al. (USP 5,824,041) in view of Martinez et al. (USP 5,453,090). Because neither of the cited patents, either alone or in combination, discloses, teaches, or suggests the subject matter of the claims, reconsideration and withdrawal of the rejections is respectfully requested.

The Lenker et al. patent discloses a delivery catheter for a radially compressible tubular prosthesis. The catheter includes a proximal anchor 258 and distal anchor 256 that cooperate to radially compress the prosthesis P, even after the sheath 254 has been fully withdrawn. (See col. 11, ll. 10-15, Figs. 19A-19D). The proximal anchor 258 cannot be a blunt edge, however, because otherwise it would not be capable of compressing the prosthesis P as described. Instead, the proximal anchor must include a structure such as the stay 124 shown in Figs. 13-15. Thus, the Lenker et al. patent does not teach or suggest a bumper member with a distal end “having a blunt edge disposed adjacent the proximal end of the prosthesis for preventing axial displacement of the prosthesis upon retraction of the tubular member with respect to the bumper member.” This feature is recited in each of claims 1 and 9 of the present application.

The Martinez patent, on the other hand, discloses a stent delivery method that includes a sheath 18 with a distal end portion 32 having weakened areas 41-45 or slits 41A-45A, (col. 4, lines 18-32), in which the stent 24 is mounted on a balloon 20 within the sheath, (col. 3, l. 66 to col. 4, l.

1). Thus, the Martinez patent also does not teach or suggest a bumper member with a distal end “having a blunt edge disposed adjacent the proximal end of the prosthesis.”

Because this claim limitation is not taught or suggested in either of the cited patents, the Examiner has failed to establish a prima facie case of obviousness for these claims.

In addition, the Examiner has shown no teaching or suggestion that would have motivated a person of ordinary skill in the art to combine the teachings of Lenker and Martinez in the manner suggested. The Examiner’s rejection thus constitutes pure (and improper) hindsight, using Applicants’ claims as a guide.

For these reasons, the Examiner’s rejection of claims 1 and 9 should be withdrawn and these claims should be allowed.

b. Claims 11-20, 37 and 39

The Examiner rejected claims 11-20, 37 and 39 under 35 U.S.C. §103(a) as being unpatentable over Lenker et al. in view of Martinez et al. further in view of Estrada et al. (USP 6,193,686), Lodin et al. (USP 5,460,608), and Thornton (USP 5,891,090). Claim 11 contains the identical claim limitation stated above concerning the bumper member “having a blunt distal edge disposed adjacent the proximal end of the prosthesis.” Claims 12-20, 37 and 39 are all dependent from claim 11, and they therefore contain the same limitation. Accordingly, for the same reasons set forth in part a. above concerning claims 1 and 9, the Examiner has failed to establish a prima facie

case of obviousness with regard to claims 11-20, 37 and 39. The rejections of these claims should be withdrawn and these claims should be allowed.

c. Claims 1, 9-18, 20, 37 and 39

The Examiner rejected claims 1, 9-18, 20, 37 and 39 under 35 U.S.C. §103(a) as being unpatentable over Sepetka et al. (USP 5,814,062) in view of Martinez et al. Because neither of the cited patents, either alone or in combination, discloses, teaches, or suggests the subject matter of the claims, reconsideration and withdrawal of the rejections is respectfully requested.

The Sepetka patent describes an occlusive implant delivery assembly including a decoupling or detachment mechanism for separating the implant from the delivery assembly. (See Abstract, Figs. 1-6). The assembly includes a catheter 4 within which an elongated carrier 26 is disposed. A coil 28 is attached to the carrier 26 by a coupling 30. Nowhere does the Sepetka patent teach or suggest a bumper member “having a blunt edge disposed adjacent a proximal end of the prosthesis” as recited in each of the rejected claims. As discussed above, neither does the Martinez patent provide this information. Thus, as above, the Examiner has failed to establish a prima facie case of obviousness of the rejected claims.

In addition, the Examiner has shown no teaching or suggestion that would have motivated a person of ordinary skill in the art to combine the disparate teachings of the Sepetka and Martinez patents in the manner suggested. The Examiner’s rejection thus constitutes pure (and improper) hindsight, using Applicants’ claims as a guide.

For these reasons, the Examiner's rejection of claims 1, 9-18, 20, 37 and 39 should be withdrawn and these claims should be allowed.

"Final" Status of Office Action

The Examiner states in the Office Action that "THIS ACTION IS MADE FINAL" because "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action." Applicant respectfully disagrees with this conclusion, and requests withdrawal of the Final status of the Office Action.

Specifically, the claim amendments made in Applicant's Amendment and Response mailed November 18, 2002 that preceded the current Office Action were only: (a) to cancel claims, (b) to comply with the Examiner's rejections of claims under § 112, or (c) to move limitations from cancelled claims into other claims. New claims were added, but the new claims were all dependent. None of these amendments necessitated the new grounds of rejection presented in the current Office Action, which grounds could just as easily have been presented in the prior Office Action. Instead, the Examiner has introduced new grounds of rejection of the claims that were not necessitated by Applicant's amendment of the claims. Thus, MPEP §706.07(a) does not support the Examiner's decision to make the current Office Action Final. As provided in MPEP §706.07(d), Applicant respectfully requests withdrawal of the Final status of the Office Action.

CONCLUSION

In view of the foregoing, it is submitted that the claims presented in this application define patentable subject matter over the cited prior art. Accordingly, reconsideration and allowance of the application is requested.

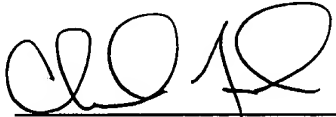
If the Examiner does not accept the foregoing request for reconsideration and does not allow the claims, Applicant requests withdrawal of the finality of the present Office Action (MPEP 706.07(d)), and submission of an additional Office Action setting forth the basis for any continued rejection of any claims.

Applicant invites the Examiner to contact the undersigned by telephone at (949) 567-6700 if doing so will clarify any issues concerning this application.

Respectfully submitted,

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